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Examiner J. Reeves, Ph.D.
Art Unit: 1642
U.S. Patent and Trademark Office
Washington, DC 20231

On June 7, 2000

By: Hugh Wang

PATENT
Attorney Docket No.: 11823-002630US
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

CARY L. QUEEN ET AL.

Application No.: 08/484,537

Filed: June 7, 1995

For: IMPROVED HUMANIZED
IMMUNOGLOBULINS

Examiner: J. Reeves, Ph.D.

Art Unit: 1642

COMMENTS ON STATEMENT OF
REASONS FOR ALLOWANCE UNDER
37 C.F.R. § 1.104(e) AND MPEP § 1302.14

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Examiner's Statement of Reasons for Allowance set forth in the Notice of Allowability mailed May 8, 2000, Applicants submit the following response, pursuant to 37 C.F.R. § 1.104(e) and MPEP § 1302.14, with reference to the paragraph numbering in the Notice of Allowability.

10 & 11. The Examiner indicated that text in the Substitute specification, specifically, from page 28, line 19 to page 29, line 35, is not present in the issued U.S. Patent No. 5,530,101, and that this text is substantive in nature. The Examiner then stated that the subject application should therefore be termed a "continuation-in-part" rather than a continuation of application Serial No. 07/634,278, which issued as Patent No. 5,530,101.

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In response, Applicants point out that the substitute specification states that the subject application "is a *continuation of application Serial No. 07/634,278*, filed December 19, 1990, Pat. No. 5,530,101, ..." (page 1, lines 5-6; emphasis added). Thus, the subject application is a continuation of the parent application serial No. 07/634,278 rather than a continuation of the issued Patent No. 5,530,101. The text noted by the Examiner is not present in the issued Patent No. 5,530,101, but, of course, was present in the 07/634,278 specification as filed (i.e., on page 62, line 19 to page 64, line 18) and in the specification as filed in the subject application. In this regard, it is to be noted that the specifications as filed in both the parent application and the subject application are identical.

As stated in the MPEP, "[a] continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and *adding matter not disclosed* in the said earlier nonprovisional application (MPEP § 201.08, citing *In re Klein*, 1930 C.D. 2, 393 O.G. 519 (Comm'r Pat. 1930); emphasis original). Here, the subject matter disclosed in the specification as filed in the subject application is identical to that of the parent application Serial No. 07/634,278, and the noted text was present in both specifications. Therefore, the mere fact that the noted text is not present in the substitute specification of the parent application and the issued Patent No. 5,530,101 does not render the subject application a continuation-in-part of the parent application. Applicants submit that the definitions of continuation and continuation-in-part relate to what are disclosed in the applications, not to what are contained in the printed patents (MPEP §§ 201.07-201.08).

In light of the above explanation, it is respectfully submitted that the subject application is a continuation of application Serial No. 07/634,278. Accordingly, the proposed Examiner's amendment regarding this issue, as indicated in paragraph 5 of the Notice of Allowability, should not have been implemented. Accordingly, an amendment under 37 C.F.R. §1.312 is being submitted under separate cover.

19 & 20. Applicants acknowledge with appreciation the corrections made by the Examiner regarding the citations of references on the form PTO-1449 submitted by Applicants on April 28, 2000. In this regard, the Examiner is advised that the correct number of the opposed EP patent is 0451216.

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on April 28, 2000. In this regard, the Examiner is advised that the correct number of the opposed EP patent is 0451216.

With respect to the submitted documents from the EP Opposition proceedings, Applicants acknowledge with appreciation the great effort by the Examiner in reviewing the large collection of documents. We also recognize that the submitted declarations were not submitted under 37 C.F.R. § 1.131 or § 1.132, but again appreciate the Examiner's review thereof.

If the Examiner believes a telephone conference would expedite issuance of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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